

**REMARKS**

The Final Office Action mailed July 8, 2009 has been reviewed and carefully considered. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 1, 4-16 and 18 and 20 are pending in this application. Claims 1, 9 and 15 have been amended. Claims 2, 3, 17 and 19 have been cancelled without prejudice. No new matter has been added.

**RESPONSE TO AMENDMENTS:**

Applicant notes with thanks the Examiner's comments in the 'Response to Amendment,' stating that the previously claimed language did not require "direct association" of emails with each other. Applicant has addressed this issue by now amending independent claims 1 and 15 to add further clarifying language regarding 'direct association' of emails to each other or to a topic.

With regards to the Examiner's comment regarding CC and BCC being options which show or hide "associations" as per the previously claimed language, Applicant notes that the independent claims 1 and 15 have been amended to specify that "associated Emails" are shown or hidden accordingly.

Regarding the Examiner's comment that Farwell teaches wherein a sender is able to 'show' or 'hide' associations to individual categories, firstly Applicant has now amended claim 9 to recite the step of displaying said discussion topic heading as a separate field in a mailbox entry in at least one of a user's mailboxes, which is not disclosed or suggested by Farwell, Anderson or Agrawal. Moreover, it is respectfully maintained that Farwell is silent

with respect to showing at least one of the discussion topic heading and associated e-mails of the reply e-mail to the recipient if the show associations option is selected.

### **§103 REJECTIONS**

Claims 1, 4-5 and 15, 16, 18 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of U.S. Patent No. 6,341,306 to Rosenschein et al. (hereinafter Rosenschein). (Please note that the Office Action on page 2 listed Claims 1, 4-5 and 15-20 as being rejected under 103; this was believed to be a typographical error as claims 17 and 19 were cancelled).

Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of U.S. 5999179 to Kekic et al. (hereinafter Kekic). Claims 9-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of “Shared Folders: Your Online Conference Room” by Doug Anderson, hereinafter “Anderson” and in further view of Microsoft Outlook 2003 Advanced Information Management in PC Today, by Jennifer Farwell (hereinafter Farwell). Applicant respectfully disagrees with the rejections.

Independent Claim 1 has been amended to recite, *inter alia*:

“...providing a direct email-to-email association option in an email program;  
indicating at least one first e-mail message in a user mailbox;  
associating the at least one first e-mail with a second e-mail by enabling the association option, wherein said step of associating further comprises enabling an options list to appear with respect to the at least one first e-mail message, said options list including at least an associate option, a show associations option, and a hide associations option;  
selecting the associate option on the options list; and  
selecting the second e-mail, wherein the second e-mail is caused to be automatically associated to the at least one first e-mail to form an associated group of e-mails; and  
forming an associated group of e-mails in the user mailbox comprising at least two or more associated e-mails;  
creating a reply email to at least one of the associated group of e-mails; and  
selecting at least one of the show associations option and the hide associations option for the reply e-mail to control whether the reply e-mail is to show the associated group of emails to a recipient..”

Independent claim 9 has been amended to recite, *inter alia*,

“...displaying said discussion topic heading as a separate field in a mailbox entry in at least one of a user's mailboxes;

Independent claim 15 has been amended to recite, *inter alia*,

“...an associate feature for providing at least one of a direct email-to-email or email-to-topic association option in an email program by enabling a user to directly link an email message to another email message or to a topic displayed as a field in a mailbox entry, thereby organizing e-mail messages to form at least one of an associated group of e-mails or an associated e-mail-to-topic group in at least one of the user's mailboxes, wherein the associated group of e-mails is formed by the user causing an options list to appear with respect to at least one first e-mail message, selecting an associate feature from said options list, and selecting a second e-mail for causing the second e-mail to be automatically associated to the at least one first e-mail to form the associated group of e-mails, wherein the options list further comprises a show associations feature and a hide associations feature; and a reply email created for at least one of the associated group of e-mails, said reply email being configured to show or hide the associated group of emails to a recipient.”

These amendments are supported by the specification, e.g., by page 5, lines 15-20, and by FIG. 1 and its corresponding description on page 5, line 8 to page 7, line 24.

Applicant respectfully maintains that the sorting system of Agrawal is for matching an incoming email to a profile of a folder; this does not disclose or relate to enabling an email to be directly associated with another email, as presently claimed. The Examiner has indeed affirmed on page 6 of the Final Office Action that Agrawal does not disclose an options list with respect to each email message, said options lists comprising an associate feature.

As stated previously, in Agrawal, one or more documents (emails) are moved into the folders based on their respective profiles. Each profile is determined based on a sample document which represents a user-desired example of the type of document that folder should contain. An incoming email is matched to a folder based on having the highest probability of matching content to the folder.

Thus, Agrawal's system is based on learning folder profiles based on sample documents and moves remaining documents into the folders accordingly. However, organizing emails by assigning them to folders with matching profiles (as in Agrawal) is not to be confused with providing a direct email-to-email association option in an email program for associating e-mails *directly to each other*, as in the present invention.

It is emphasized that in Agrawal, since emails are organized by simply being assigned to folders, **a new folder must be created for each different topic**, and furthermore, in order for Agrawal's document association to occur, a sample document or rules representative of the desired classification indicia must then be put into the folder to represent its profile. *See* Col. 4, lines 51-60:

"[A]s shown in block 50, the user can establish a tree-like hierarchy of empty folders by conventional means... Moving to block 52, the user inputs, for each folder, one or more classification indicia in the form of sample documents. In addition, the user can define classification rules such as "send all emails from John to folder #3."

Agrawal requires a folder to be set up in advance (for each desired topic, no less) in order to organize its emails. In stark contrast to Agrawal, the present invention advantageously provides a user-controlled e-mail organization technique **which eliminates the need to create a new folder for each discussion topic, and does NOT require prior creation of folders**. In Agrawal, it is clear that any 'grouping' function involves wherein only emails which are similar to a sample document can be grouped together, and thus in any way 'associated' with each other.

Accordingly, Agrawal fails to disclose or suggest at least an associate feature for providing at least one of a direct email-to-email or email-to-topic association option in an email program, essentially as recited in claims 1 and 15.

Furthermore, Agrawal fails to disclose or suggest at least selecting at least one of

the show associations option and the hide associations option for the reply e-mail to control whether the reply e-mail is to show the **associated group of emails** to a recipient, essentially as claimed in Claims 1 and 15. Indeed, it is reiterated that the entire system and method of Agrawal is directed towards organizing documents on a user's personal computer only. There is no mention whatsoever of any means for controlling whether or not emails associated with a given email are to be displayed to a recipient, namely, whether a reply email being sent out is to show its associated group of emails to the recipient.

It is respectfully asserted that Rosenschein fails to cure the deficiencies of Agrawal. Rosenschein involves a system for obtaining and retrieving information from a database by designating at least one word appearing in a display of a body of text generated by a first computer, wherein the at least one designated word is transmitted via a network to a second computer. Data relating to the at least one designated word are received from the second computer. However, Rosenschein has nothing to do with email organization, much less organizing e-mail messages to form at least one of an associated group of e-mails or an associated e-mail-to-topic group in at least one of the user's mailboxes. Indeed, the Examiner merely cited Rosenschein as allegedly teaching right clicking on an 'options list'. However, it is readily apparent that Rosenschein fails to disclose or suggest at least providing a **direct email-to-email association option in an email program**, or selecting at least one of the show associations option and the hide associations option for the reply e-mail to control whether the reply e-mail is to show the **associated group of emails** to a recipient, essentially as claimed in Claim 1. Rosenschein also fails to disclose or suggest at least an associate feature for providing at least one of a direct email-to-email or email-to-topic association option in an email program by enabling a user to directly link an email message to another email message or to a topic displayed as a field in a mailbox entry, or a reply email created

for at least one of the associated group of e-mails, said reply e-mail being configured to show or hide the associated group of emails to a recipient, essentially as claimed in claim 15.

With respect to claim 9, Applicant respectfully asserts that Agrawal, Anderson and/or Farwell fail to disclose or suggest at least:

- controlling whether at least one of the user-defined discussion topic heading and at least one associated email is to be displayed to a recipient of the at least one email message by selecting at least one of a show associations option and a hide associations option on a reply e-mail to be sent to a recipient; and
- showing at least one of the discussion topic heading and **associated e-mails** of the reply e-mail to the recipient if the show associations option is selected.

Applicant notes that with respect to claim 9, the Examiner has affirmed that Agrawal does not disclose creating a user-defined discussion topic heading, said discussion topic heading appearing as an entry in at least one of user's mailboxes. The Examiner alleges that 'common folder naming convention' renders this obvious; however, Applicant has now amended claim 9 to recite: "displaying said discussion topic heading as a separate field in a mailbox entry in at least one of a user's mailboxes," which Applicant asserts is not disclosed or suggested by Agrawal, Anderson and/or Farwell. It is emphasized that the topic heading of the present invention is displayed as a **field** in a mailbox entry (i.e., in addition to other mailbox fields, such as subject heading, date, etc. as per page 5, lines 15-20 of the present specification).

The Examiner also asserts that Agrawal does not disclose selecting whether to show a user-defined discussion topic and related email to a recipient and cites Farwell as allegedly disclosing this feature. The Applicant respectfully disagrees.

Farwell is directed to a file organization system limited to each user's computer. The cited "Choose A Category" section of Farwell discusses a "Categories tool" which lets a user identify a variety of items (e.g., email messages) as they relate to a situation or purpose, such

as Ideas or Time and Expenses. With regards to emails, Farwell states that emails may be assigned to previously created categories. Namely, page 2 of Farwell recites:

“Even more importantly for multitaskers, you can assign an unlimited number of categories to an item. For example, you could assign an email about a sales meeting to Sales and Meetings categories, and the email would show up in both categories.”

At most, Farwell’s disclosed ‘assigning of items to categories’ is simply another organizational technique, and does not relate in any way with creating a **reply** to an email that is from a group of associated emails, the **reply being configured to show or hide its associated emails to a recipient**, as essentially recited in claim 9 of the present invention.

Anderson fails to cure the deficiencies of Agrawal and Farwell. Anderson generally describes ‘folder rights’ in which documents in the shared folder carry their own set of rights, independent of the rights granted by the folder. In Anderson, users must be granted rights to documents in a shared folder by the owner of the document. However, this is not to be confused with controlling whether at least one of the user-defined discussion topic heading and at least one **associated** email is to be displayed to a recipient of the at least one email message by selecting at least one of a show associations option and a hide associations option on a reply e-mail to be sent to a recipient, as presently claimed in claim 9. Instead, in Anderson, each document owner must separately grant the user the right to simply view a *document*. There is no provision in Anderson enabling a user to control whether a recipient of an email message is be shown a **user-defined discussion topic heading or associated email messages to the email message being sent**.

Accordingly, it is respectfully asserted that independent Claims 1 and 15 are patentably distinct and non-obvious over Agrawal in view of Rosenschein for at least the reasons set forth above. Claims 4-6 and 8 depend from claim 1 and are therefore believed to be patentable and nonobvious for at least the reasons stated for claim 1. Claims 16, 18 and 20

depend from claim 15 and are therefore believed to be patentable and nonobvious for at least the reasons stated for claim 15. Claims 2, 3, 17 and 19 have been cancelled without prejudice.

Also, it is respectfully asserted that independent Claim 9 is patentably distinct and non-obvious over Agrawal in view of Anderson and/or Farwell for at least the reasons set forth above. Claims 10-14 depend from claim 9 and are therefore believed to be patentable and nonobvious for at least the reasons stated for claim 9.

With respect to the §103 rejection of claim 7, the rejection of claim 7, is based, in part, on the contention that Agrawal discloses or suggests the features of claim 1, from which claim 7 respectively depends. However, in light of the above amendments and discussion, it is clear that the combination of Agrawal and/or Kekic is legally deficient, since, at the very least, as explained above, Agrawal does not disclose or suggest the features of claim 1, from which claim 7 depends.

It is therefore respectfully submitted that the present invention is not disclosed or suggested by the cited references taken alone or in combination. Claims 1, 4-16 and 18 and 20 are believed to be in condition for allowance for at least the reasons stated above. Early and favorable reconsideration of the case is respectfully requested.

**CONCLUSION**

In view of the foregoing, Applicant respectfully requests that the rejections of the claims set forth in the Final Office Action of July 8, 2009 be withdrawn, that pending Claims 1, 4-16 and 18 and 20 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicant's representatives Deposit Account No. 07-0832.

Respectfully submitted,

Dated: 9-10-09

By: J.D.H.  
Jeffrey D. Hale  
Registration No. 40,012

**Mailing Address:**

**THOMSON LICENSING LLC  
PATENT OPERATIONS  
P.O. BOX 5312  
PRINCETON, NJ 08543-5312**